

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

ECOFACTOR, INC., Plaintiff, v. ECOBEE, INC., Defendant.	Case No.: 6:20-cv-00078-ADA JURY TRIAL DEMANDED
ECOFACTOR, INC., Plaintiff, v. ECOBEE, INC., Defendant.	Case No.: 6:21-cv-00428-ADA JURY TRIAL DEMANDED

JOINT MOTION TO CONSOLIDATE ACTIONS

Plaintiff EcoFactor, Inc. (“EcoFactor”) and Defendant ecobee, Inc. (“ecobee”) hereby jointly move to consolidate the above-captioned actions under Case No. 6:21-cv-00428-ADA.

In Case No. 6:20-cv-00078-ADA (“the -00078 Action”), the parties are set to begin trial on September 26, 2022. Two patents remain asserted in the -00078 Action: U.S. Patent No. 8,738,327 (“the ’327 patent”) and U.S. Patent No. 10,534,382 (“the ’382 patent”). However, EcoFactor has filed a motion to dismiss without prejudice Count IV of the Complaint alleging infringement of the ’382 patent, in light of the Patent Trial and Appeal Board (“PTAB”) of the USPTO recently issuing a Final Written Decision finding the asserted claims unpatentable. *See, e.g.*, -00078 Action, Dkt. No. 139. While EcoFactor is appealing the PTAB’s decision, it agrees with ecobee that this Court should not hold a trial on the ’382 patent unless and until that decision is overturned.

In the interim, the parties agree that it would make efficient use of party and judicial resources to consolidate the remaining claims of the -00078 Action (all of which relate to the '327 patent) with the claims at issue in Case No. 6:21-cv-00428-ADA ("the -00428 Action"), which involves (a) the same parties and products, (b) overlapping witnesses and evidence, (c) overlapping factual and legal issues, and (d) other EcoFactor asserted patents. Trial in the -00428 Action is scheduled to begin on March 21, 2023. *See* -00428 Action, Dkt. No. 31. Consolidating these two separate cases under the -00428 Action will avoid the need for this Court to hold two trials within six months of each other involving overlapping issues and witnesses.

To implement the proposed consolidation, the parties stipulate and agree to the following terms:

1. All discovery materials and filings in the -00078 Action will be treated as though they were submitted in the consolidated -00428 Action, subject to the additional terms below.
2. By September 13, 2022 (i.e., four weeks before the close of fact discovery), the parties shall update the discovery responses and document productions previously provided in the -00078 Action solely to include (1) updated financial documents and information, and (2) documents and information regarding ecobee's two new thermostat products that were released in May 2022 (Smart Thermostat Enhanced and Smart Thermostat Premium).
3. Solely for purposes of litigating the alleged infringement of the '327 patent, ecobee stipulates that there is no material difference between the accused functionality and relevant source code of the Smart Thermostat Enhanced and Smart Thermostat Premium, on the one hand, and the accused ecobee Smart Thermostat with Voice Control, on the other hand, the latter of which was already addressed in the parties' expert reports. Consequently, EcoFactor's same infringement arguments and ecobee's same non-infringement arguments apply to the Smart Thermostat Enhanced and Smart Thermostat Premium. However, for avoidance of doubt, ecobee does not stipulate—and nothing herein prejudices ecobee from arguing—that the Smart Thermostat Enhanced and Smart Thermostat Premium are materially different from Smart Thermostat with Voice Control for purposes other than analyzing infringement of the '327 patent—including, for example, for purposes of analyzing infringement of the patents currently in issue in the -00428 Action.
4. On or before October 18, 2022 (the deadline for opening expert reports on the patents already at issue in the -00428 Action), opening expert reports previously

submitted in the -00078 Action may be supplemented to address updated sales data and ecobee's two new thermostat products. On or before November 15, 2022 (the deadline for rebuttal expert reports on the patents already at issue in the -00428 Action), rebuttal expert reports previously submitted in the -00078 Action may be supplemented to address new material contained in supplemental opening reports. The technical expert reports of Mr. Zeidman and Dr. Souris will be supplemented only to reference the parties' Stipulation 3 above and convey that their existing opinions therefore apply to ecobee's two new thermostat products. Supplements to the damages expert reports of Mr. Kennedy and Ms. Riley will be consistent with their existing damages theories. Mr. Kennedy and Ms. Riley each may be deposed for up to two hours on the supplemental contents of their supplemental reports. Given the very narrow purpose of their supplemental reports, there will be no further deposition of Mr. Zeidman or Dr. Souris regarding their -00078 Action reports.

5. The following three motions, which are presently pending in the -00078 Action, will be decided in the proposed consolidated -00428 Action: (1) ecobee's Corrected Motion to Strike New Infringement Theories (Dkt. No. 90); (2) ecobee's Corrected Motion to Exclude the Damages Opinions of David Kennedy (Dkt. No. 91); and (3) EcoFactor's Motion to Exclude Opinions of ecobee's Damages Expert Michele Riley (Dkt. No. 94).
6. The parties shall serve new pretrial disclosures on January 10, 2023, thus replacing the pretrial disclosures previously served in the -00075 Action.
7. ecobee agrees not to seek a stay or otherwise delay trial of the consolidated -00428 Action, absent (1) serious and unanticipated illness or injury to lead counsel or experts that would prevent such individuals from participating in the trial as scheduled to begin on March 21, 2023, or (2) other unforeseen and serious events that would make it unreasonable or impossible to try the case as scheduled.
8. All existing motions *in limine* and pending evidentiary objections will be deemed moot, and the parties will submit new motions *in limine* and objections in the normal course in advance of the new trial date.
9. All current deadlines in the -00078 action not addressed above will be vacated.

The parties respectfully request that the Court consolidate these actions. Should the Court wish to discuss any questions regarding how the requested consolidation would be implemented, the parties are available at the Court's convenience.

Dated: July 11, 2022

Respectfully submitted,

/s/ Reza Mirzaie

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CERTIFICATE OF SERVICE

I certify that all counsel of record are being served with a copy of the foregoing document via the Court's CM/ECF system.

Dated: July 11, 2022

By: */s/Kristopher R. Davis*
Kristopher R. Davis